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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,836	04/30/2001	Timothy Griffin	033275-212	1029

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Robert S. Swecker
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

PRICE, CARL D

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant No.

09/843,836

Applicant(s)

GRIFFIN ET AL.

Examiner

CARL D. PRICE

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04-12-2002 (preliminary amend), 11-06-02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6 6) ☐ Other: _____

DETAILED ACTION

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant's election with traverse of claims 1,5-11,18,19 and 24 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that "The Restriction Requirement is traversed because it is believed that the species of Figures 4-9 are drawn to sufficiently interrelated inventions to warrant examination thereof in a single application" and "...a complete search for any one of the above referenced species would necessarily encompass a search for the subject matter of the remaining species". This is not found persuasive because the analysis to determine patentability of each of applicant's claimed separate and distinct inventions, as well as the additional burden of search necessarily to discern relevant prior art relating to each of the claimed species, necessarily presents a serious burden on the examiner.

The requirement is still deemed proper and is therefore made **FINAL**.

Claims 2-4,12,13,14,15-17 and 20-23 are withdrawn

Claims 2-4,12,13,15-17 and 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

While not specifically set forth in the examiners Restriction Requirement, applicant has defined the invention of figure 9 as a separate species corresponding to applicant's claim 23. Since claim 23 is not directed to the elected specie of figure 4 it is also withdrawn from further consideration as being drawn to a nonelected species.

Claim 14 is also withdrawn from further consideration as being drawn to a nonelected species, since claim 14 depends from non-elected claim 13.

Specification

The disclosure is objected to because of the following informalities: On page 1 of the specification, the information referencing the German priority document must be updated.

Appropriate correction is required.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

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the references have been cited by the examiner on form PTO-892, or by applicant on form PTO-1449, they have not been considered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 1) woven fiber material (claim 10) and 2) the catalytic active and inactive channels (claims 6-8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1,9,10,18,19 and 24: rejected under 35 U.S.C. 102(b)

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Claims 1,9,10,18,19 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP '577 (EP 0 577 117).

EP '577 shows and discloses a catalytic operating structure formed from a corrugated (figures 1, 2) porous woven catalytic coated fiber material forming passages (see figures 3,4) where due to the open characteristics of the woven material adjoining channels communicate with each other. In regard to claims 18 and 19, in particular, EP '577 further shows several layers (1,2; figure 7) that are oriented differently. In regard to claim 19, in particular, the apexes of the corrugations are shown to rest on each other.

In regard to all of the claims, the recitation that the catalyst operates as a "burner" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Also, the intended operation of the catalyst as a "burner" is deemed a recitation of the intended use of the claimed invention and does not patentably distinguish the claimed invention from the prior art. A recitation of intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 1,9,10,18,19 and 24: rejected under 35 U.S.C. 102(b)

Claims 1,9,11,18,19 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hottenhofer et al (US '832).

US '832 shows and discloses a catalytic operating structure formed from a corrugated (figure 7) porous metal foil catalytic coated material forming passages (138) permitting adjoining channels to communicate with each other. In regard to claims 18 and 19, in particular, US '832 shows several layers that are oriented differently where the apexes of the corrugations are shown to rest on each other.

In regard to all of the claims, the recitation that the catalyst operates as a "burner" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Also, the intended operation of the catalyst as a "burner" is deemed a recitation of the intended use of the claimed invention and does not patentably distinguish the claimed invention from the prior art. A recitation of intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

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the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8: rejected under 35 U.S.C. 103(a)

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '117 or US '832 in view of Dalla Betta et al (US 5248251) and Betta et al (US 5512250).

Both EP '117 and US 832 show and disclose the invention as set forth in the claims. However, EP '117 and US '832 do not disclose inactive and active channels, or zones, as set forth in applicants claims.

EP '577 shows and discloses a catalytic operating structure formed from a corrugated (figures 1, 2) porous woven catalytic coated fiber material forming passages (see figures 3,4) where due to the open characteristics of the woven material adjoining channels communicate with each other. EP '577 further shows several layers (1,2; figure 7) that are oriented differently. The apexes of the corrugations are shown to rest on each other.

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US '832 shows and discloses a catalytic operating structure formed from a corrugated (figure 7) porous metal foil catalytic coated material forming passages (138) permitting adjoining channels to communicate with each other. US '832 shows several layers that are oriented differently where the apexes of the corrugations are shown to rest on each other.

Dalla Betta et al and Betta et al both teach, from the same catalytic structure field of endeavor as EP '117 and US '832, providing different catalytic activity zones (see Dalla Betta et al; figure 2c) and active and inactive channels (see Betta et al; figures 1-7) for the purpose of defining reaction area in order to active a desired overall effect on the gases in the structure.

In regard to claims 6-8, for the purpose of defining reaction area in order to active a desired overall effect on the gases in the structure, it would have been obvious to a person having ordinary skill in the art to modify the catalytic structure of EP '117 an US '832 to include inactive and active coated channels, or zones, as set forth in applicants claims, in view of the teachings of Dalla Betta et and Betta et al.

Conclusion

See the attached PTO FORM 892 for prior art made of record and not relied upon and which are considered pertinent to applicant's disclosure.

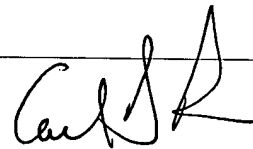
USPTO CUSTOMER CONTACT INFORMATION

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1148/0858.



CARL D. PRICE
Primary Examiner
Art Unit 3743

cp
January 27, 2003